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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TERMANINI, SAMIR	
ART UNIT	PAPER NUMBER
2178	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/736,492	FISCHER ET AL.	
	Examiner	Art Unit	
	Samir Termanini	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/26/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

BACKGROUND

1. This action is responsive to the following communications: Application filed on 12/15/2003.

2. Claims 1-27 are pending in this case. Claims 1, 10, and 19 are in independent form.

3. The information disclosure statement (IDS) filed on 4/26/2004 has been acknowledged and considered by the examiner. The Initial copy of form PTO-1449 is included in this office action.

CLAIM REJECTIONS - 35 U.S.C. §101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 19-27** are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, and further raises questions as to whether the claims are directed to an abstract idea.

More specifically, although the word "system" appears in the preamble, the claims actually appear to be directed to software that is not embodied on a computer-readable medium. Therefore, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. §101. They are clearly not a series of steps or acts, to be a process, nor are they a combination of chemical compounds to

be a composition of matter. Claims 19-27 fail to define any structural and functional interrelationships between the "system" and other elements of a computer that permit the "system's" functionality to be realized. Additionally, all of the "means for" limitations recited throughout claims 19-25 and claims 26-27's dependencies encompass a software-only system because the applicant has evoked 35 U.S.C. §112 6th Paragraph and explains in the specification: "The present invention can be realized in ...software..." (para. [0031]). Therefore, claims 19-27, being directed toward non-functional descriptive material *per se*, fail to fall within a statutory category.

6. For the purposes of examination, claims 19-27 are being examined as if they were directed toward subject matter claimed as a process.

CLAIM REJECTIONS - 35 U.S.C. §103

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 1-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Blades et al.* (US Pat No. 5,420,975 A) in view of *White* (US Pat No. 5,386,494 A).

As to independent **claim 1**, *White* discloses: A method of aiding a visual search in a list of learnable speech commands ("...menu allows the user to learn the different words or phrases...." col. 9, lines 3-5) comprising: presenting a display list of commands to a user ("This menu will be displayed to the user " col. 9, lines 20-21). However, *White* does not

show (as clearly as the cited secondary reference) measuring an evidentiary value related to the monitoring selection of a command; comparing the evidentiary value to a programmed value to determine if an adjustment criteria has been satisfied; and adjusting the display of the selected command.

Blades et al. disclose monitoring whether the user has selected a command ("For each menu, a counter is provided which counts the number of times a user selects the particular menu." col. 2, lines 58-61); measuring an evidentiary value related to the selected command ("...a minimum menu counter threshold could be set to 50 indicating that the menu must be utilized 50 times..." col. 3, lines 23-27); comparing the evidentiary value to a programmed value to determine if an adjustment criteria has been satisfied ("Thereafter, block 78 illustrates a determination of whether or not a menu option counter divided by the menu counter is greater than the menu threshold for the user." col. 4, lines 22-25); and adjusting the display of the selected command ("In this manner, each user selection of a menu option is utilized in order to continuously and automatically update and alter the display " col. 3, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have combined the list of learnable speech commands taught in *White* with the evidentiary value based adjusting of *Blades et al.*

First, the level of ordinary skill in the art at the time of the invention was such that it was well known that modifying the visual appearance of a command can be accomplished through "visual adjustment" highlighting items in a list of commands to in order to obtain a user's attention (*Blades et al.,* col. 5, lines 65-67). It was further within the level of ordinary skill in the art at the time of the invention to display a list of learnable speech commands

for user selection (*White,* col. 10, lines 20-25). And still further, speech commands improve efficiency of human machine interfaces ("In order to make the human/machine interface even more efficient and user-friendly, computers are being designed to recognize and respond to the user's spoken words." col. 1, lines 60-65).

Secondly, both *Blades et al.* and *White* are in analogous art as they are directed to the same problem of presenting selectable menu options commands (Blades et al., col. 1, lines 5-17)(White, col. 10, lines 23-25) as well the same field of endeavor of data processing systems ("data processing system," *Blades et al.*, col. 1, lines 8-11; *See also* "data processing system," *White*, see claim 1).

Finally, *Blades et al., inter alia,* provides an expressly stated motivation: "It should therefore be apparent that a need exists for a method and system for automatically altering a display of user selectable menu options without a direct action by a user."(*Blades et al.*, col. 1, lines 42-45)(emphasis added) Congruently, *White* suggests that a list of learnable speech commands for user selection "...make[s] locating, identifying, and cataloging alternative commands easier and faster." (col. 2, lines 55-56).

As to dependent claims 2 and 4, which depends from claim 1, *White* and *Blades et al.*, teach the limitations of claim 1, treated above. However, *White* did not show (as clearly as the cited secondary reference) the display list of commands being adjusted by lightening the selected command if the adjustment criteria have been satisfied. *Blades et al.* further teaches the display list of commands is adjusted by lightening and dimming the selected command ("If the menu option counter divided by the menu counter is less than the established threshold for the particular menu, the display of the menu option associated with the menu option counter is automatically altered...The display may be altered by

dimming the intensity of the display of the menu option, changing the displayed color of the menu option, or any other manner of alteration." col. 3, lines 1-12) if the adjustment criteria has been satisfied ("is less than the established threshold for the particular menu, the display of the menu option associated with the menu option counter is automatically altered." col. 3, lines 3-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have combined the list of learnable speech commands taught in *White* with the lightening of a selected command based on adjustment criteria of *Blades et al.* because it is taught to be, "...an improved method for the automatic alteration within a data processing system."(*Blades et al.,* col. 1, lines 48-50).

As to dependent **claim 3**, which depends from claim 1, *White* further teach the display list of commands is adjusted ("In turn, each voice pull-down menu contains a list of alternative commands which corresponds to the subject matter portrayed by the voice icons." col. 7, lines 1-15) by moving the selected command down the display list of commands if the adjustment criteria has been satisfied ("The voice pull down menu is displayed when the voice icon associated with that pull down menu is selected. The alternatives may be arranged alphabetically or logically grouped to help the user find the desired alternative. " col. 7, lines 1-15). Accordingly, this claim is rejected for the same reasons set forth in claim 1.

As to dependent **claim 5**, which depends from claim 1, *White* further disclose(s): The method of claim 1, wherein the display list of commands is adjusted by moving the selected command up the display list of commands ("thereby shortens the list" col. 9, lines. 5-9) if the adjustment criteria has not been satisfied ("contains alternative command" col. 9, lines. 7-12). Accordingly, this claim is rejected for the same reasons set forth in claim 1.

As to dependent **claims 6-7**, which depends from claim 1, *White* further discloses that the display list of commands is adjusted by darkening or lightening all of the display list of commands except the selected command based on the adjustment criteria (see fig. 5A; see also "white on black background" col. 7, lines 65). Accordingly, this claim is rejected for the same reasons set forth in claim 1.

As to dependent **claim 8**, which depends from claim 1, *White* further discloses that the display list of commands are commands "...to help the user find the desired alternative..."(col. 7, lines 5-15). Accordingly, this claim is rejected for the same reasons set forth in claim 1.

As to dependent **claim 9**, which depends from claim 1, *White* further disclose(s): The method of claim 1, wherein the evidentiary value is selected from a time value (e.g. "the duration that pointer button 29 is kept depressed"). Accordingly, this claim is rejected for the same reasons set forth in claim 1.

As to independent **claim 10**, this claim differs from claim 1 only in that it is directed to a product defined by the process of claim 1. Accordingly, this claim is rejected for the same reasons set forth in the treatment of claim 1, above.

As to dependent **claims 11-18**, these claims differ from claims 2-9, respectively, only in that they are directed to products defined by the processes of claims 2-9, respectively. Accordingly, claims 11-18 are rejected for the same reasons set forth in the treatment of claims 2-9, respectively.

As to **claims 19-27**, these claims differ from claims 1-10, respectively, only in that they are directed to a "system" defined by the processes of claims 1-10, respectively.

Accordingly, claims 19-27 are rejected for the same reasons set forth in the treatment of claims 1-10, respectively.

CONCLUSION

9. Although not relied upon, the following prior art is made of record because it considered pertinent to applicant's disclosure:

[1] Ozeki (US 5125071 A) for teaching adapted to inputting commands.

[2] Falcone et al. (US 5396264 A) for teaching a corresponding each menu item displayed on a display.

[3] Barber et al. (US 5923325 A) for teaching a command key corresponding with the particular help desired.

[4] Ortega et al .(US 6085159 A) for teaching with each voice a command in the list; displaying in response to a user request a command and each of its associated variables; and, displaying each of the associated variables within delimiters to indicate to the user that a choice must be made from a set of choices for each the associated variable together with the command.

[5] Kurapati (US 20020075320 A1) for teaching generating recommendations for one or more items based on the consistency with which an item was selected relative to the number of times the item was offered.

[6] Ishii (US 20020180804 A1) for teaching data pieces which are frequently used are displayed at the same display positions, thereby allowing easy retrieval and selection of a desired command or data piece depending on a user's memory.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samir Termanini whose telephone number is (571) 270-1047. The Examiner can normally be reached from 9 A.M. to 4 P.M., Monday through Friday (excluding alternating Fridays).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, *see* http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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